

Rejections based on 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 1-15 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants submit that the pending claims are definite.

The Examiner alleged that the term “optical coherent pigment” is not clearly defined in the claims or the specification. Applicants respectfully disagree with the Examiner. On page 4, lines 17-25, the specification states that an optical coherent pigment is capable of developing color by an interference action of light. The optical coherent pigments can include, for example, materials such as mica (see page 4, line 26 to page 5, line 3). Mica and other optical coherent pigments typically have a structure that can be cleaved into sheets or platelets (e.g., scales or flakes).

The Examiner alleged that the term “scaly” renders claims 3 and 7 indefinite. Applicants disagree with Examiner. The term is used to describe the structure of optical coherent pigments such as mica that have a structure that can be cleaved into sheets.

The Examiner rejected claim 6 for using improper Markush group terminology. Applicants have corrected the wording of the claim to recite that the pigment comprises titanium dioxide-coated mica flake, iron oxide-coated mica flake, or a combination thereof.

The Examiner alleged that claim 7 was unclear. The claim has been amended to clarify that bismuth trichloride is a separate example of a suitable pigment.

The Examiner alleged that claim 8 was indefinite because it was not clear if the colored layer is required to be laminated before the clear layer. The claim has been amended to recite that the decorative film has a structure arranged in an order of adhesive layer, transparent substrate, colored layer, and clear layer.

The Examiner alleged that claim 9 was indefinite because it was not clear if the adhesive layer is required to be laminated first onto the substrate before the colored and clear layers. The claim has been amended to recite that the decorative film has a structure arranged in an order of transparent substrate, colored layer, clear layer, and adhesive layer.

Applicants respectfully request withdrawal of all the rejections based on U.S.C. § 112, second paragraph.

Rejection based on U.S.C. § 102

The Examiner rejected claims 1-4 and 6-7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,747,153 (hereinafter "US '153") issued to McDaniel. Applicants submit that the pending claims are not anticipated by US '153.

US '153 discloses glass objects and ceramic objects having a thin lustrous coating that contains luster pigment particles.

The decorative films of the present invention include a transparent substrate and a colored layer. The transparent substrate includes a plastic film. US '153 discloses a colored layer but does not disclose a decorative film. The colored layer is applied directly to a glass or glazed ceramic. There is no plastic film between the glass or glazed ceramic and the colored layer. The reference also fails to disclose that the colored layer is not observable when viewed from the first side of the decorative film but is observable when viewed from the opposite side of the decorative film.

US '153 does not disclose all the claim limitations of independent claim 1. Thus, this reference does not disclose all the claim limitations of dependent claims 2-4 and 6-7 of the present invention. Applicants respectfully request withdrawal of the rejection based on anticipation by US '153.

Rejection based on U.S.C. § 103 over U.S. Patent No. 5,747,153

The Examiner rejected claim 5 under 35 U.S.C. § 103(a) as obvious over US '153. Applicants submit that the pending claims are not obvious over US '153.

MPEP § 2143 provides that three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations.

Applicants submit that the Examiner has not established a *prima facie* case of obviousness. As discussed above, US '153 does not disclose all the claim limitations of claim 1. Further, this reference provides no suggestion or motivation to apply the colored layer to a transparent plastic film rather than directly to the glass or ceramic object. Further, the reference does not teach or suggest that the colored layer can be viewed from one side but not the other side of a decorative film.

Applicants respectfully request withdrawal of the obviousness rejection based on US '153.

Rejection based on U.S.C. § 103(a) over U.S. Patent No. 5,747,153 in view of JP3143575

The Examiner rejected claims 8-9 under 35 U.S.C. § 103(a) as obvious over US '153 in view of JP3143575 (hereinafter "JP '575"). Applicants submit that the pending claims are not obvious over the combination of these references.

Claims 8-9 are dependent on claim 1. As discussed above, claim 1 is not obvious over US '153. The reference JP '575 does not overcome the deficiencies of US '153.

The Abstract for JP '575 discloses a coating that includes a colored layer, an interference mica containing base layer, and a clear layer on a substrate. There is not teaching or suggestion in JP '575 that the colored layer is anything other than opaque and a colored layer is not inherently transparent.

There is no disclosure in the combination of US '153 and JP '575 of a decorative film that includes a transparent plastic film and a transparent colored layer. The combination of references fails to teach or suggest that the colored layer is not observable when viewed from the first side of the decorative film but is observable when viewed from the opposite side of the decorative film.

Claim 1 is not obvious over US '153 in view of JP '575. Thus, dependent claims 8-9 are not obvious over this combination of references. Applicants respectfully request withdrawal of the obviousness rejection based on the combination of US '153 and JP '575.

Rejection based on U.S.C. § 103(a) over EP 0 578 829 in view of U.S. Patent No. 5,747,153 and JP3143575

The Examiner rejected claims 1-15 under 35 U.S.C. § 103(a) over EP 0 578 829 (hereinafter "EP '829") in view of US '153 and JP '575. Applicants respectfully submit that the pending claims are not obvious over this combination of references.

EP '892 discloses a laminated body that includes a light transmitting or glare protecting base material and a layer containing a glittering pigment. There is no

teaching or suggestion that the laminated body is transparent when viewed from one side as recited in claim 1 of the present invention. There is no disclosure that light passes through the device. To the contrary, in embodiments such as in figures 1-6, a light intercepting protective film is provided to prevent transmission of light from the side of the laminated body opposite the viewer. In other embodiments such as in figures 7-20, an intermediate resin layer containing a pigment is positioned between two light transmitting films or bases. The light transmitting film or base allows a first colored layer to be viewed on one side of the laminated body and another colored layer to be viewed on the other side of the laminated body.

There is no disclosure that the colored layer is transparent. There is no teaching or suggestion that the colored layer is not observable when viewed from the first side of the decorative film but is observable when viewed from the opposite side of the decorative film. Rather, in some embodiments, the decorative film can be viewed from one side only. In other embodiments, a different colored layers are seen when observed on opposite sides of the laminated body.

As the Examiner noted, EP '892 also fails to teach or suggest that the colored layer has a thickness in the range of about 2 microns to 20 microns.

Thus, EP '892 fails to teach or suggest all the limitations of claim 1 of the present invention. The present invention is not obvious over EP '892.

The deficiencies of EP '892 are not removed by US '153. This combination of references fails to teach or suggest that the colored layer is not observable when viewed from the first side of the decorative film but is observable when viewed from the opposite side of the decorative film. There is no teaching or suggestion that the colored layer is transparent.

Although US '153 has a colored layer with a thickness in the range of the present invention, the colored layer in US '153 is not on a transparent plastic film but applied as a glazing material to a glass or ceramic object. Thus, the teaching in US '153 would provide no direction to an inventor interested in developing a decorative film having a colored layer that is observable from one side of the decorative film but not from the other side.

Thus, the present invention is not obvious over the combination of EP '892 and US '153. The reference JP '575 fails to remove the deficiencies of these references.

The combination of references fails to teach or suggest that the colored layer is not observable when viewed from the first side of the decorative film but is observable when viewed from the opposite side of the decorative film. The combination provides no teaching or suggestion that the colored layer is transparent.

The combination of references does not teach all the limitations of claim 1 or dependent claims 2-14. Applicants request withdrawal of the obviousness rejection based on the combination of EP '892, US '153, and JP '575.

Pending claims 1-15 are in condition for allowance. A Notice of Allowance is earnestly requested.

Respectfully submitted,

February 18, 2003
Date

By: Jean A. Lown
Jean A. Lown, Reg. No.: 48,428
Telephone No.: (651) 733-3169

54834US007 Response to OA 12-3-02
Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833



Versions with markings to show changes made to SN 09/914,562

Amend claims 1 and 6-9.

1. A decorative film [for a glass-paned window, said film] comprising a transparent substrate and a colored layer comprising ink containing an optical coherent pigment, said colored layer having a thickness in the range of from 2 to 20 μm and being provided on one surface of said substrate, wherein said substrate comprises a plastic film and said colored layer is not observable when viewed from a first side of the decorative film but is observable when viewed from an opposite side of the decorative film.

6. The decorative film according to claim 2, wherein said polarizing pearl ink contains a pigment and said pigment comprises [is at least one of a scaly titanium dioxide-coated mica flake, [and] iron oxide-coated mica flake, or a combination thereof.

7. The decorative film according to claim 2, wherein said polarizing pearl ink [contains] comprises a pigment from the group [consisting] of [a] titanium dioxide-coated mica flake, iron oxide-coated mica flake, [and] bismuth trichloride, a scaly glass flake, and combinations thereof.

8. The decorative film according to claim 1, further comprising a clear layer and an adhesive layer, wherein said colored layer and said clear layer are laminated[, in order,] on said one surface of said transparent substrate, and said adhesive layer is provided on another surface of said transparent substrate opposite said colored layer, wherein the decorative film has a structure arranged in an order of adhesive layer, transparent substrate, colored layer, and clear layer.

9. The decorative film according to claim 1, further comprising a clear layer and an adhesive layer, wherein said colored layer, said clear layer and said adhesive layer are laminated[, in order,] on said one surface of said transparent substrate, wherein the decorative film has a structure arranged in an order of transparent substrate, colored layer, clear layer, and adhesive layer.

RECEIVED
FEB 28 2013
TC 1700 MAIL ROOM